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EXAMINER	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DALE F. MCINTYRE

Appeal 2007-3649
Application 09/892,043
Technology Center 2100

Decided: May 29, 2008

Before LANCE LEONARD BARRY, HOWARD B. BLANKENSHIP, and THU A. DANG, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-24. The Appellant appeals therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

A. ILLUSTRATIVE CLAIM

Claim 1, which illustrates the invention, follows.

> 1. A method for providing an automatic service over a communication network to a user based on stored instructions by a user on a user computer, comprising the steps of:
>
> automatically initiating the obtaining of instructions stored on a user computer over said communication network by a service provider, said instructions being associated with a digital media file stored on said user computer; and
>
> implementing said instructions with respect to said associated digital image file.

B. REJECTIONS

Claims 1-8, 12-20, and 24 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,321,231 ("Jebens"); U.S. Patent No. 5,737,491 ("Allen"); and U.S. Patent No. 6,381,636 ("Cromer").

Claims 9-11 and 21-23 stand rejected under § 103(a) as obvious over Jebens; Allen; Cromer; and U.S. Patent No. 6,035,323 ("Narayen").

II. ISSUE

"Rather than reiterate the positions of the parties *in toto*, we focus on an issue therebetween." *Ex parte Kuruoglu*, No. 2007-0666, 2007 WL 2745820, at *2 (BPAI 2007). The Examiner makes the following findings.

> Jebens discloses a means for receiving instructions from the first user directing that the electronic file be delivered to a second user, and automatically routing the electronic file; see col. 3, lines 5-10. Further, in column 18, line 63 to column 19,

> line 10, Jebens discloses the system automatically moves the file to a processing queue and then compresses the file per predetermined compression settings, in which the communication portion of the local computer then establishes a connection with the host site.

(Ans. 7.) The Appellant argues that in the reference "it is the image provider computer that initiates the communication. In the present invention, it is the service provider that initiates the action and obtains instructions stored on the local computer." (Supp. App. Br. 6.) Therefore, the issue is whether the Examiner has shown that in Jebens a service provider automatically obtains instructions stored on a user's computer.

"Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims . . . . The second step in the analyses requires a comparison of the properly construed claim to the prior art." *Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933 (Fed.Cir. 2003) (internal citations omitted).

III. CLAIM CONSTRUCTION

"Claims must be read in view of the specification, of which they are a part." *Markman v. Westview Instruments, Inc.,* 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc).

Here, claim 1 recites in pertinent part the following limitations: "automatically initiating the obtaining of instructions stored on a user computer over said communication network by a service provider . . . ." Claims 12, 13, and 24 include similar limitations. For its part, the

Appellant's Specification discloses "a service provider automatically obtaining instructions stored on a user computer. . . . ." (P. 3.) Reading the claim in view of the Specification, the limitations require that a service provider automatically obtains instructions stored on a user's computer.

IV. OBVIOUSNESS ANALYSIS

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). "'A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.'" *In re Bell*, 991 F.2d 781, 783 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976)).

Here, regarding the first part of Jebens relied on by the Examiner, we agree with the Appellant that "column 3, lines 5-10 is directed to the situation where instructions are provided by the user 12 that provide instructions for a host 10 for delivering of files to an identified second user such as supplier 16. *See* Col. 21, line 62 - Col. 22, line 42." (Supp. App. Br. 6.) More specifically, the reference's explanation that "[t]he user's computer will then send the work order to the host site 10" (col. 22, ll. 41-42) supports the argument that the user's computer supplies the instructions rather than the host site automatically obtaining the instructions therefrom.

Regarding the second part of Jebens relied on by the Examiner, we agree with the Appellant that "it is the image provider computer that initiates the communication." (Supp. App. Br. 6.) More specifically, the reference's following disclosure supports the argument that the user's local computer supplies the instructions rather than the host site automatically obtaining the instructions therefrom. "The communication portion of the local computer then establishes a connection with the host site 10 or other destination by automatically dialing or sending a network request; establishes a valid communication link; passes identification information to the destination computer; and, once the communication link is established, transmits the file." (Col. 18, l. 66 – col. 19, l. 5.)

V. CONCLUSION

The Examiner does not allege, let alone show, that the addition of Allen, Cromer, or Narayen cures the aforementioned deficiency of Jebens. Absent a teaching or suggestion of a service provider automatically obtaining instructions stored on a user's computer, we are unpersuaded of a prima facie case of obviousness.

VI. ORDER

For the aforementioned reasons, we reverse the rejections of claims 1, 12, 13, and 24. "Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim." 37 C.F.R. § 1.75 (2007). Claims 2-11 and 14-23 depending from

claims 1 and 13, respectively, we also reverse the rejection of the former claims.

REVERSED

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